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RB34506240X

In re application of : Gary R. Tucholski et al.
Serial No. : 07/641,394
Filed : January 15, 1991
For : BATTERIES WITH TESTER LABEL

MAR 20 1996

#43
(N/E)

United States Patents and Trademark Office
Office of the Assistant Commissioner for Patents
Attention: Gerald A. Dost, Special Program Examiner
Special Program Examination Unit
Crystal Park 2, Suite 919
Washington, D.C. 20231

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**OFFICE OF PETITIONS
AND PATENTS**

OBJECTION TO PETITION FOR ACCESS

A Petition for Access to the captioned application was filed by Warren N. Low on or about February 23, 1996. Mr. Low alleges, as grounds for access, that United States Patent 5,223,003 claims the benefit of the filing date of this application. This is not the first such petition which has been filed seeking access to this application on this ground.

One such petition was filed by Peter W. Peterson on or about September 27, 1993. Another was filed by Dana M. Schmidt on or about September 7, 1993. A third was filed by Stephen D. Murphy on or about August 18, 1993. The decisions on each of these petitions is attached. Each uniformly grants access to only: (1) the examiner's restriction requirement of January 9, 1992 (Paper No. 4); (2) applicant's response thereto filed January 17, 1992 (Paper No. 5); (3) the portions of the next Office action mailed March 27, 1992 (Paper No. 6), making the restriction requirement final, which are the first page, the first two paragraphs on page 2, and the last paragraph on page 3; and (4) parts of the amendment filed

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October 2, 1992 (Paper No. 7), consisting of page 4, the paragraph canceling claims 43-45, and page 5, the first paragraph under "Remarks."

The facts today are identical to those which formed the basis for each of the attached decisions. Nothing has changed. It is altogether proper, thus, that the instant petitioner's access to this application be limited to the same extent as has the access of petitioners in the past. Applicants enclose two copies of the materials to which access has previously been granted.

Prudence, nevertheless, requires that applicants restate the bases for objection to this and previous petitions. These bases are set forth in the ensuing paragraphs. Applicants are aware, of course, that the attached decisions implicitly reject some of these arguments in minor respects.

"Whenever a patent relies on the filing date of an earlier but still pending application, the public is entitled to see the portion of the earlier application *that relates to the common subject matter*, and also what prosecution, if any, was had in the earlier application *of subject matter claimed in the patent*." M.P.E.P. §103 (emphasis added), *citing In re Dreyfus*, 137 USPQ 475 (Comm'r Pat. 1961).

Applicant objects to this Petition insofar as it seeks access to the prosecution of Application 641,394. The ground for this objection, succinctly stated, is that no prosecution has taken place in Application 641,394" of the subject matter claimed in" United States Patent 5,223,003.

United States Patent 5,223,003, more particularly, issued from Application Serial No. 813,234 filed December 23, 1991. Application Serial No. 813,234 was a continuation-in-part of Application 641,394.

Applicant's attorney has compared the specification of this application to that of United States Patent 5,223,003 and determined that the specification of Application 641,394 is substantially incorporated into that of the patent. Applicant has determined, for this reason, that access to Application 641,394 (but not its prosecution history) is proper.

Applicant's attorney has also reviewed the prosecution of this application and compared it with the claimed subject matter in United States Patent 5,223,003. Each of the claims of the patent specifically recites the step of applying "a layer having a color contrasting to the color of the thermally sensitive material between the conductive layer and thermally sensitive material." No claim of comparable scope has been prosecuted in Application 641,394. No claim of comparable scope, in fact, could have been prosecuted in this application because this application does not even

disclose the step of applying a color-contrasting layer. This step was the subject matter added in the continuation-in-part application.

Further, Application 641,394, as filed, contained claims 1-44 directed to "a battery" and claim 45 directed to a "process for attaching a label comprised of a tester for a battery to a battery." The examiner, in the initial Office Action, required a restriction between claims 1 to 44 and claim 45, finding that they were drawn to distinct inventions. Claims 1-44 were elected for purposes of prosecution and process claim 45 was subsequently canceled.

Applicant added claims 46-53 to Application 641,394 on October 2, 1992, each of these claims, like original claims 1-44, being drawn to a "battery." Applicant added additional claims to Application 641,394 on October 22, 1992. These additional claims, numbered 54-70, were copied from United States Patent 5,059,895, issued October 22, 1991, to Cataldi et al. These claims were presented for purposes of provoking an interference with the Cataldi et al. patent and appropriate declarations under 37 C.F.R. §1.608 accompanied them. Claims 54-61 were drawn to a "label." Claims 62-70, again, were drawn to a "battery."

The claims of United States Patent 5,223,003 are drawn to a "process for preparing a label comprising a tester for a battery and attaching

it to a battery," while on the other hand, all of the application claims are drawn to an apparatus, *i.e.*, to a battery or to a label. Accordingly, the apparatus claims in Application 641,394 cannot be considered to constitute subject matter claimed in the patent within the meaning of M.P.E.P. §103.

There exists, in short, no prosecution in this application "of subject matter claimed in the patent." M.P.E.P. §103. Petitioner is therefore not entitled to access to the prosecution of this application. Petitioner is entitled, rather, only to access to this application as filed. Such access is furnished by serving herewith one copy upon Petitioner.

Petitioner notes that Application 641,394 is involved in Interference 103,036 with five additional patents or applications, four of which the non-interference prosecution history is open to the public (two patents and two pending reissue applications). Petitioner also notes that Application 641,394 is already open to the public by virtue of European Patent Application 495,636, which claims priority to the Application 641,394 filing date. However, neither of these factors is relevant to the decision as to whether or not access to the prosecution history of Application 641,394 should be granted. Petitioner has failed to establish

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any significance of these two facts as they relate to access to this
application.

Respectfully submitted,

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